

Application No.: 10/721,154

Docket No.: JCLA10379-R

REMARKS**Present Status of the Application**

This is a full and timely response to the outstanding final Office Action mailed Jul. 20, 2006. Applicants submit that claims 1, 11-13, 25, and 36 have been amended for better readability only; and the other claims remain unchanged from their original forms. The amended claims are fully supported by the specification. Reconsideration and allowance of the application and presently pending claims 1-46 as amended are respectfully requested.

Discussion of Office Action Rejections

The Office Action rejected claims 1, 6-8, 10-13, 18-20, 22-25, 30-32, 36, and 41-43 under 35 U.S.C. 103(a) as being unpatentable over Ishizuka et al. (Ishizuka), US Patent No. 6,101,391.

Applicants submit that the 103(a) rejections were not properly made in compliance with the requirements set forth in 35 U.S.C.

It has been held that "patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case" (MPEP 2141). However, in rejecting the present invention, as set forth in claims 1, 6-8, 10-13, 18-20, 22-25, 30-32, 36, and 41-43, the Examiner fails to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. Four

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factual inquires enunciated from *Graham v. John Deere Co.* as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Specifically, in rejecting the present invention as set forth in claims 1, 6-8, 10-13, 18-20, 22-25, 30-32, 36, and 41-43 as being obvious over Ishizuka, the Examiner failed to determine the scope and contents of the prior art, and ascertain the differences between the prior art and the claims in issue. Applicants submit that if the Examiner had found such differences between the present invention and the prior art, i.e., Ishizuka, the differences must be ascertained and clearly given in the Office Action document; and if the Examiner found no such difference therebetween, the Office Action should be made based on 35 U.S.C. 102, rather than 35 U.S.C. 103. Furthermore, to render the present invention obvious and therefore unpatentable over Ishizuka, a secondary reference or Examiner's own knowledge must be used to modify Ishizuka, and suggestions or teachings of the proposed modification must be found in the prior art. However, the Examiner fails to provide any suggestions or teachings to do any modification or combination toward Ishizuka to render the present invention *prima facie* obvious.

Accordingly, if the Examiner insists to reject the present invention upon the basis of 103(a), a next Office Action, fully complying with *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103, is invited. If the Examiner

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would like to turn to another 102 rejection instead, the current Final Office Action based on 35 U.S.C. 103 should be withdrawn.

Furthermore, Applicant submit that claims 1, 6-8, 10-13, 18-20, 22-25, 30-32, 36, and 41-43, are novel and unobvious over Ishizhuka, or any of the other cited references, taken alone or in combination, and thus should be allowed.

With respect to claim 1, as amended, recites in part:

... wherein when the first cellular phone is operating, the digital cellular phone system processes the steps of:
the first cellular phone registering the digital cellular phone system and keeping contact with the base station;
the first cellular phone registering an entry notice function to the digital cellular phone system;
the base station informing the first cellular phone when the second cellular phone registers the digital cellular phone system and keeps contact with the base station; and
informing the second cellular phone to switch to a wireless system for getting in contact with the first cellular phone thereby,
wherein the first cellular phone has an identification function of the base station serving for identifying when the second cellular phone registers the wireless system, the identification function comprising inputting a password by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone. (Emphasis added)

Applicant submits that such a digital cellular phone system as set forth in claim 1 is neither taught, disclosed, nor suggested by Ishizuka, or any of the other cited references, taken alone or in combination.

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Ishizuka fails to disclose, teach or suggest the following steps that are required by the present invention as set forth in claim 1:

1. **the base station informing the first cellular phone when the second cellular phone registers the digital cellular phone system and keeps contact with the base station;**
2. **"informing the second cellular phone to switch to a wireless system for getting in contact with the first cellular phone thereby"; and**
3. **"the first cellular phone has an identification function of the base station serving for identifying when the second user registers the wireless system, the identification function comprising inputting a password by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone" (emphasis added).**

Above three steps have been summarized by the Examiner as presented in the current Office Action (page 2) as following:

- a) informing the second cellular phone to switch to a wireless system;
- b) the first cellular phone informed that the second user is switching; and
- c) the first cellular phone has an identification.

The Examiner contends that "Ishizuka teaches that:

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1. A first mobiles station (MS1) is provided with a keyboard as input means, having a notifying button for calling out other mobile stations in a group, e.g., MS2 and MS3 (see col. 5, lines 52-65);
2. Mobile stations (MS1-MS3) have a group ID that is stored and used at the time registration with the administration base station or the like; and
3. Each mobile station in the group are aware of a mobile station leaving the group or geographical area.

Hence Examiner contends that Ishizuka reads on the present invention as claimed.” (See page 2 of the current Office Action)

According to above-recited Examiner’s narrations, Applicants understand that the Examiner likely believed that all above-specified points have been disclosed or taught by Ishizuka, and in such a manner, the Examiner believed that “Ishizuka reads on the present invention as claimed”.

Applicants submit that when being alleged as reading on the claimed subject matter, the prior art must be proved to be identical as the claimed invention. Although the Examiner alleged that Ishizuka “teaches that: ‘a first mobiles station (MS1) is provided with a keyboard as input means, having a notifying button for calling out other mobile stations in a group, e.g., MS2 and MS3’ (see col. 5, lines 52-65)”, it is insufficient to read on either “the base station informing the first cellular phone when the second cellular phone registers the digital cellular phone system and keeps contact with the base station”, or “informing the second cellular phone to switch to a wireless system for getting in contact with the first cellular phone thereby”. As

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contented by the Examiner, the mobiles stations (MS1-MS3) of Ishizuka have the functions of processing the steps as required by the claimed invention. However, Ishizuka does not really teach, disclose, or suggest such steps should process at that specified circumstances and all the elements should arrange as required by the claimed invention.

Further, even the Examiner contended that Ishizuka disclosed that "each mobile station in the group is aware of a mobile station leaving the group or geographical area", it does not expressly give evidence to read on "the base station informing the first cellular phone when the second cellular phone registers the digital cellular phone system and keeps contact with the base station", because Ishizuka is silent about the situation of when a mobile station moving in the group or geographical area.

For at least the foregoing reasons, Ishizuka fails to teach each and every elements as set forth in claim 1, and therefore, claim 1 and its dependent claims 6-8, 10-12 are submitted to be novel and unobvious over Ishizuka or any of the other cited references, taken alone or in combination, and thus should be allowed.

In a similar manner, claim 13, recites in part:

....wherein when the first cellular phone is operating, the digital cellular phone system process the steps of:
the first cellular phone registering the digital cellular phone system and keeping contact with the base station;

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the first cellular phone registering an entry notice function to the digital cellular phone system;

the base station informing the first cellular phone when the second cellular phone registers the digital cellular phone system and keeps contact with the base station; and

the first cellular phone being informed that the second cellular phone has registered to the second base station near to the first base station, the second cellular phone is informed to switch to a wireless system for getting in contact with the first cellular phone thereby,

wherein the first cellular phone has an identification function of the base station serving for identifying when the second cellular phone registers the wireless system, the identification function comprising inputting a password by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone.

Ishizuka fails to disclose, teach or suggest the steps of:

1. the base station informing the first cellular phone when the second cellular phone registers the digital cellular phone system and keeps contact with the base station;
2. the second cellular phone is informed to switch to a wireless system for getting in contact with the first cellular phone thereby; and

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3. the first cellular phone has an identification function of the base station serving for identifying when the second cellular phone registers the wireless system, the identification function comprising inputting a password by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone.

Therefore, claim 13 as amended should not be considered as being anticipated by Ishizuka, or any of the other cited references, taken alone or in combination.

Likewise, claim 25, recites in part:

... wherein when the second cellular phone registers the digital cellular phone system and keeps contact with the base station, the base station informs the first cellular phone which has registered the entry notice function to the cellular phone system, and the second cellular phone is then informed to switch to a wireless system for getting in contact with the first cellular phone thereby, wherein the first cellular phone has an identification function of the base station serving for identifying when the second cellular phone registers the wireless system, the identification function comprising inputting a password by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone. (Emphasis added)

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Ishizuka '391 fails to disclose, teach or suggest a limitation of "the second cellular phone is then informed to switch to a wireless system for getting in contact with the first cellular phone thereby, wherein the first cellular phone has an identification function of the base station serving for identifying when the second user registers the wireless system, the identification function comprising inputting a password by the second user and/or identifying a subscriber identity module of the second cellular phone", which is required for the digital cellular phone system as set forth in claim 25 (emphasis added). Therefore, claim 25 as amended should not be considered as being anticipated by Ishizuka or any of the other cited references, taken alone or in combination.

Likewise, claim 36, recites in part:

...wherein when the second cellular phone registers the digital cellular phone system and keeps contact with the second base station, the first base station informs the first cellular phone which has registered the entry notice function to the cellular phone system, and the second cellular phone is then informed to switch to a wireless system for getting in contact with the first cellular phone thereby, wherein the first cellular phone has an identification function of the base stations serving for identifying when the second cellular phone registers the wireless system, the identification function comprising inputting a password

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by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone. (Emphasis added)

Ishizuka '391 fails to disclose, teach or suggest a limitation of "the second cellular phone is then informed to switch to a wireless system for getting in contact with the first cellular phone thereby, wherein the first cellular phone has an identification function of the base stations serving for identifying when the second cellular phone registers the wireless system, the identification function comprising inputting a password by the second cellular phone and/or identifying a subscriber identity module of the second cellular phone", which is required for the digital cellular phone system as set forth in claim 36 (emphasis added). Therefore, claim 36 as amended should not be considered as being anticipated by Ishizuka or any of the other cited references, taken alone or in combination.

Applicant submits that such a digital cellular phone system as set forth in claim 13 and such a first cellular phone as set forth in claims 25 and 36 are neither taught, disclosed, nor suggested by Ishizuka, or any of the other cited references, taken alone or in combination and therefore should be allowed.

Accordingly, claims 1, 13, 25 and 36 are submitted to be novel, unobvious, and patentable over Ishizuka '391, and the rejection should be withdrawn.

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If independent claim 1 is allowable over the prior art of record, then its dependent claims 6-8 and 10-12 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

If independent claim 13 is allowable over the prior art of record, then its dependent claims 18-20 and 22-4 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

If independent claim 25 is allowable over the prior art of record, then its dependent claims 30-32 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

If independent claim 36 is allowable over the prior art of record, then its dependent claims 41-43 are allowable as a matter of law, because these dependent claims contain all features of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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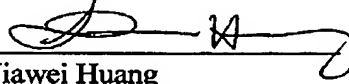
CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1, 6-8, 10-13, 18-20, 22-25, 30-32, 36, and 41-43 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,
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